

Remarks

Claims 1-29 and 31 are pending. Claims 1-4, 8-11, 15-18, 22-25, 29 and 31 were rejected under Section 102 as being anticipated by Reed (6426801). Claims 5-7, 12-14, 19-21 and 26-28 were rejected under Section 103 as being obvious over Reed in view of Hirai (6493108). The rejections are based on the Examiner's assertion that Reed teaches printing thumbnail images in the same orientation in which the image files were acquired. This assertion is not correct.

The Examiner recognizes that Reed does not expressly teach printing thumbnail images in the same orientation in which the image files were acquired. In the Response to Arguments section at page 2 of the Office Action, the Examiner instead advances what appears to be an inherency argument:

"As long as the orientation of image [sic] is not changed after saving an image on disk, there is no suggestion in Reed to think that orientation of the image will be printed any other way than originally saved. Reed certainly does not suggest changing the orientation data of an image. Thus the thumbnail image will be printed with the original orientation as image [sic] was taken and saved in a file." Office Action, page 2.

To support anticipation under Section 102, the Examiner must look at what the reference teaches, not what the reference suggests. Reed does not expressly teach printing thumbnail images in the same orientation in which the image files were acquired, and the Examiner makes no assertion to the contrary. Printing thumbnail images in the same orientation in which the image files were acquired is also not inherent in Reed. As noted in the Background section of the instant application, in the conventional approach, thumbnail images on index pages are all printed in landscape orientation without regard to the orientation of the full size image or how it was acquired. Application, page 2, lines 6-11. Exhibit A to this Response, for example, is an index page that accompanied a Kodak Picture CD from about December 2003 (belonging to the undersigned) in which all of the thumbnails are presented and printed in a landscape orientation despite the fact that some of the images (e.g., numbers 8, 20 and 22) were acquired in a portrait orientation. See also, U.S. Patent No. 6434579 to Shaffer (assigned to Eastman Kodak Co.), Fig. 4, for a conventional "all landscape" thumbnail orientation index page.

On this record, there is no reason to **assume**, as the Examiner has done, that Reed prints thumbnail images in the same orientation in which the image files were acquired. On the contrary, it is reasonable to assume only that Reed use the conventional approach of printing thumbnails in landscape without regard to the orientation of the original image.

To establish inherency, the Examiner must show that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. ***The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*** In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112, paragraph IV. The Examiner has not, as yet, made the required showing.

For this reason alone, the rejections of all of the pending claims, which are based on Reed, should be withdrawn.

Further with regard to Claims 2, 9, 16 and 23, Reed does not teach printing an index page of thumbnails of a selected subset of the image files. The Examiner asserts incorrectly that Reed teaches this limitation at column 7, lines 25-40. The cited passage addresses printing the full size image associated with one or more of the thumbnail images. The cited passage says nothing about printing thumbnail images or index pages containing thumbnail images. In fact, Reed does not teach printing thumbnails of only a subset of the image files. Instead, Reed teaches printing thumbnail images of "all photo on camera card." Block 128 on Fig. 10 and column 7, lines 18-23.

For this additional reason, Claims 2, 9, 16 and 23 distinguish patentably over Reed.

The foregoing is believed to be a complete response to the outstanding office action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Ormiston', is written over a horizontal line.

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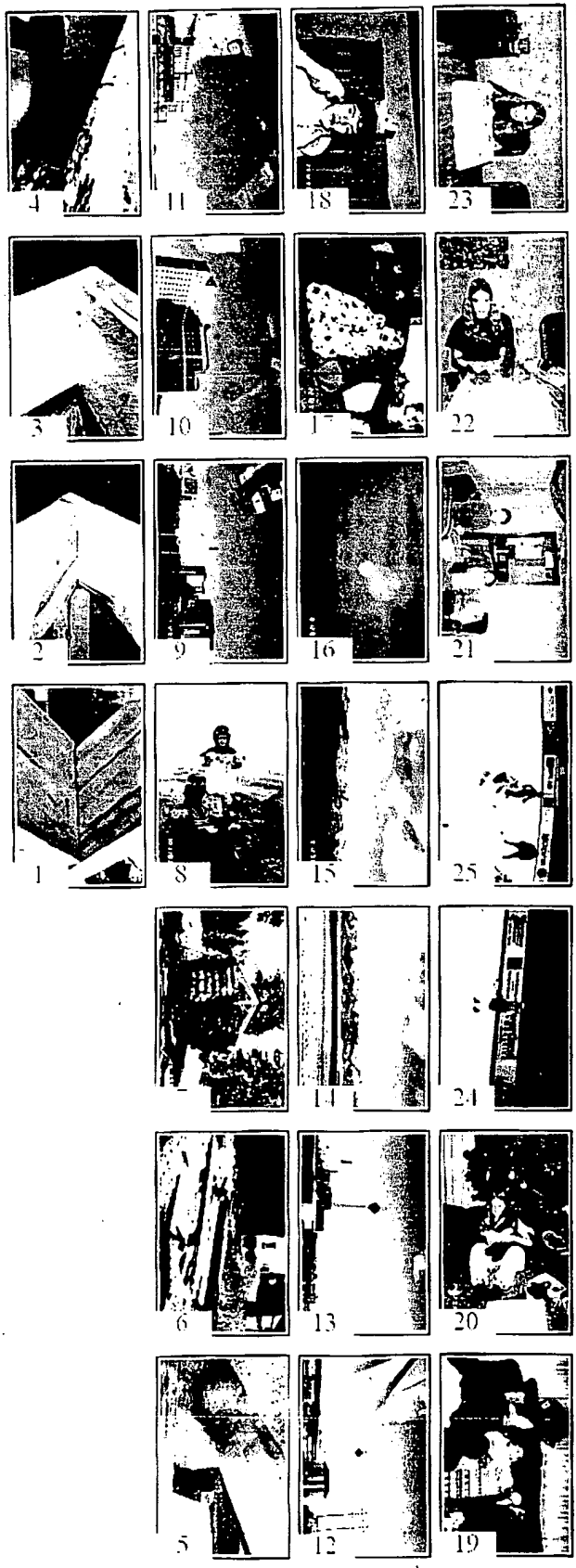
Exhibit "A"



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Picture CD

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